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DEC 06 2005

OFFICE OF PETITIONS

In re Application of :
Fillebrown et al. :
Application No. 09/773,885 :
Filed: February 1, 2001 : ON PETITION
Title of Invention: :
PERSONAL WIRELESS NETWORK :

This is a decision in response to the Petition Under 37 C.F.R. § 1.47 in Support of Declaration of Prior Invention Under 37 C.F.R. § 1.131, filed October 24, 2005, requesting the Declaration of Prior Invention Under 37 C.F.R. § 1.131 be made by the signing inventors on behalf of themselves and the nonsigning inventor. The petition is properly treated as a petition under 37 CFR 1.183 seeking waiver of 37 CFR 1.131 to the extent that it requires all of the named inventors execute the declaration filed thereunder¹.

This Petition is hereby dismissed.

Petitioner's assert that the claimed invention, the subject matter of which is described and claimed in the above identified application, was conceived prior to the effective date of the reference, and was diligently reduced to practice by all of the application's named inventors. Petitioner's further assert that, after diligent effort, inventor Lisa Fillebrown, is unavailable.

In support of this assertion, Petitioner's file the Declaration of Robert A. Samra wherein Mr. Samra provides that, at his direction, Ms. Kathryn Thomas unsuccessfully attempted to contact Ms. Fillebrown at the address in the Assignee's records. Thereafter

¹ Rule 47 only applies where, in the first instance, the signature of an originally named, or to be added, inventor can not be obtained. As all of the inventors executed the original declaration, filed February 1, 2001, and thus made the application, 37 CFR 1.47 no longer applies to this case. See, 37 CFR 1.47; MPEP 201.03. Rather, the remedy lies under 37 CFR 1.183 when a required affidavit or declaration of a prior invention to overcome a cited patent or publication, under 37 CFR 1.131, is not executed in whole or in part by a previously signing inventor. See, MPEP 715.04.

Ms. Thomas searched the local telephone directories for a listing for Ms. Fillebrown, but was again unable to locate her. Mr. Samra then provides that he inquired with several employees and/or officers of the Assignee who had worked with Ms. Fillebrown while she was employed with the Assignee, but none of the employees had any knowledge as to the current location of Ms. Fillebrown.

No declaration from Ms. Thomas has been provided, nor have copies of the results of searches of the local telephone directories.

Applicable Law, Rule, or MPEP

As provided in MPEP 715.04,

[a]ffidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s).

Here, Applicant avers that inventor Fillebrown is unavailable to make the affidavit or declaration. As such, Applicant must qualify under 37 CFR 1.47(a).

37 CFR 1.47(a)

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) set forth above.

As to item (1), if an inventor is unavailable (cannot be reached), Petitioner must establish the exercise of diligent effort in trying to find or reach the nonsigning inventor. Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having

firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions. (Emphasis supplied). See, MPEP § 409.03(d).

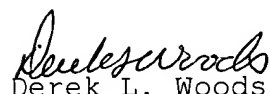
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 PO Box 1450
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By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
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 401 Dulany Street
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Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.


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